

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed July 17, 2007. Claims 1-60 were pending in the Application. In the Office Action, Claims 1-60 were rejected. Claims 1-60 remain pending in the Application. Applicant respectfully requests reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

**SECTION 103 REJECTIONS**

Claims 1-11, 15-17, 19-23, 25-33, 36-40, 42-44, 46-48, 50-55 and 57-60 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0134650 issued to Sundar (hereinafter "Sundar") in view of U.S. Patent No. 2003/0134650 issued to Beach et al. (hereinafter "Beach"). Claims 12-14, 18, 24, 34-35, 41, 49 and 56 were rejected under 35 USC §103(a) as being unpatentable over *Sundar* in view of *Beach* and in view of U.S. Patent Publication No. 2004/0003285 issued to Whelan et al. (hereinafter "Whelan"). Claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Sundar* in view of *Beach* and U.S. Patent Publication No. 2004/0153676 issued to Krantz (hereinafter "Krantz"). Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d

1173, 1183 (Fed. Cir. 1991). Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

Sundar in view of Beach: Claims 1-11, 15-17, 19-23, 25-33, 36-40, 42-44, 46-48, 50-55, and 57-60

Claims 1-11, 15-17, 19-23, 25-33, 36-40, 42-44, 46-48, 50-55 and 57-60 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Sundar* in view of *Beach*. Applicant traverses the rejection.

Of the rejected Claims, Claims 1, 16, 26, 37, 42, 52, and 57 are independent. Claim 1 recites "detecting at least one wireless network within which a wireless device is located while the wireless device is in a transmit off mode" (emphasis provided). Applicant respectfully submits that the Examiner has failed to establish a *prima facie* obviousness rejection of Claim 1. In the Office Action, the Examiner appears to assert that the combination of *Sundar* and *Beach* results in the invention recited by Claim 1. (Office Action dated July 17, 2007, page 2). Applicant respectfully disagrees. For example, *Sundar* appears to disclose that the presence of a WLAN can be detected by one of two methods:

Passive Scanning: the station 310 searches for a beacon frame broadcast by the 802.11x AP 204

Active Scanning: the station 310 transmits probe request frames and waits for probe response frames from the AP 204

(*Sundar*, paragraphs 0056 and 0057). The cited text appears to simply indicate that, when in the passive scanning mode, the station 310 device of *Sundar* is not transmitting probe request frames but is searching for a beacon frame broadcast transmitted by a access point device of *Sundar*. (*Id.*).

*Beach* appears to disclose a mobile unit configured to operate in a power save mode in order to conserve battery power within the mobile unit. (*Beach*, paragraph 0023). In *Beach*, the power save mode appears to power down the entire communications or radio frequency unit (e.g., transmit/receive module) until the mobile unit of *Beach* has prepared and is ready to transmit a transmit packet to an access point of *Beach*. (*Id.*). Therefore, in *Beach*, when in the

power save mode, no communications appear to occur between the mobile unit and the access point.

In the Office Action, the Examiner appears to rely on *Beach* to teach “a transmit off mode” as recited by Claim 1. (Office Action dated July 17, 2007, page 2). However, contrary to the Examiner’s assertion, Applicants respectfully submit that the combination of *Sundar* and *Beach* does not result in the limitation of “detecting at least one wireless network within which a wireless device is located while the wireless device is in a transmit off mode” as recited by Claim 1 (emphasis added). As indicated above, *Beach* appears to disclose that when operating in the power save mode, the *Beach* device does not appear to be able to transmit or receive data. Therefore, if the *Sundar* mobile device is modified to include the power save mode of *Beach*, Applicant respectfully submits that the *Sundar* device would not be able to perform the “passive scanning” operation relied on by the Examiner in *Sundar*. Thus, even combined, the references do not disclose or even suggest “detecting at least one wireless network within which a wireless device is located while the wireless device is in a transmit off mode” as recited by Claim 1. Thus, the Examiner has failed to establish a *prima facie* obviousness rejection of Claim 1. Accordingly, Applicants respectfully submit that Claim 1 is patentable over the references.

Independent Claims 16, 26, 37, 42, 52, and 57 each generally recite detecting a wireless network while the wireless device is in a “transmit off mode,” and independent Claim 42 recites “a wireless device . . . [with] application logic adapted to selectively switch the wireless device between a transmit on mode and a transmit off mode based on an identification of at least one wireless network” (emphasis added). For at least the reasons discussed above in connection with independent Claim 1, Applicant respectfully submits that independent Claims 16, 26, 37, 42, 52 and 57 are also patentable over the references.

Claims 2-11, 15, 17, 19-23, 25, 27-33, 36, 38-40, 43, 44, 46, 48, 50, 51, 53-55 and 58-60 that depend respectively from independent Claims 1, 16, 26, 37, 42, 52 and 57 are also patentable over the cited references at least because they incorporate the limitations of respective Claims 1, 16, 26, 37, 42, 52 and 57 and also additional elements that further distinguish the references. Therefore, Applicant respectfully requests that the rejection of Claims 1-11, 15-17, 19-23, 25-33, 36-40, 42-44, 46, 48, 50-55 and 57-60 be withdrawn.

Sundar in view of Beach in view of Whelan: Claims 12-14, 18, 24, 34-35, 41, 49 and 56

Claims 12-14, 18, 24, 34-35, 41, 49 and 56 were rejected under 35 USC §103(a) as being unpatentable over *Sundar* in view of *Beach* and in view of *Whelan*. Applicant respectfully traverses this rejection.

Claims 12-14, 18, 24, 34-35, 41, 49, and 56 depend respectively from independent Claims 1, 16, 26, 37, 42, and 52. As shown above, Claims 1, 18, 26, 37, 42, and 52 are patentable over *Sundar* and *Beach*. Therefore, for at least this reason, Claims 12-14, 18, 24, 34-35, 41, 49, and 56 which depend therefrom are also patentable over *Sundar* and *Beach*. *Whelan* does not appear to remedy, nor does the Examiner rely on *Whelan* to remedy, at least the deficiencies of *Sundar* and *Beach* indicated above. Accordingly, for at least this reason, Applicant respectfully requests that the rejection of Claims 12-14, 18, 24, 34-35, 41, 49, and 56 be withdrawn.

Sundar in view of Beach in view of Krantz: Claim 45

Claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Sundar* in view of *Beach* and *Krantz*. Applicant respectfully traverses this rejection.

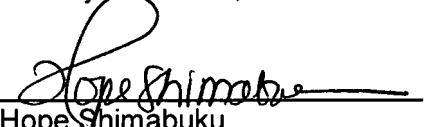
Claim 45 depends from independent Claim 42. As shown above, Claim 42 is patentable over *Sundar* and *Beach*. Therefore, for at least this reason, Claim 42 which depends from independent Claim 42 is also patentable over *Sundar* and *Beach*. *Krantz* does not appear to remedy, nor does the Examiner rely on *Krantz* to remedy, at least the deficiencies of *Sundar* and *Beach* indicated above. Accordingly, for at least this reason, Applicant respectfully requests that the rejection of Claim 45 be withdrawn.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicant has overlooked the need for any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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